

## **REMARKS**

It was requested in the Office Action that Figures 1 and 3-5 should be labeled as "Prior Art" in light of Ho, U.S. Patent No. 5,805,298. In response, applicants are submitting proposed drawing changes that have labeled FIG. 4 as prior art. Applicants have declined to label FIG. 1 as prior art because FIG. 1 shows a controller having a CPU and memory that are not shown in Ho's figures. Additionally, applicants have declined to label FIG. 3 as prior art because this drawing shows a server 30 that is not shown in Ho. Lastly, applicants have declined to label FIG. 5 as prior art because this drawing also shows a server that is not taught in Ho.

It was requested in the Office Action that the serial number of the U.S. Application mentioned on page 11 be updated along with its status. In response, the applicants have amended the specification to provide the serial number and filing date, as provided above. The application cited on page 11 is still pending. A version with markings to show changes made is attached to this Office Action.

Claims 1-18 stand rejected under 35 USC 103(a) as being unpatentable over Ho et al, U.S. Patent No. 5,805,298, alone. It is contended in the Office Action that Ho teaches all the claimed elements of the applicants' invention with the exception of specifically sending a message via both facsimile and email. The Examiner further contended, however, that it would have been obvious to those skilled in the art to send the message via both facsimile and e-mail, thereby making the rejected claims obvious. The applicants respectfully traverse this contention of obviousness, and provide the following argument to show that these claims are nonobvious.

Applicants contend that it was not obvious to those skilled in the art at the time the invention was made to send a message both via facsimile and e-mail. The Examiner cites no references to show that sending a message via both facsimile and e-mail was in fact obvious to those skilled in the art.

Furthermore, it is the applicants' position that there is no motivation to modify Ho to send the message via both facsimile and email because such a combination would destroy the stated function of the Ho invention.

Ho teaches a communications device that transmits and receives information in accordance with both facsimile and electronic mail communications protocols. The communications device recognizes a destination identifier, identifying a remote communications device as either a facsimile device or an email device and transmits a document in accordance with the communications protocol utilized by the identified device. In order to transmit the document, Ho's invention requires that there be a direct connection from Ho's communication device 100 to the receiving device. As shown in FIGs. 3 and 4, Ho does not transfer any document unless there is a successful direct connection (308, 310 and 318 of FIG. 3; 406, 408, 410 of FIG. 4). In fact, Ho indicates a failure if no such direct connection can be established (318 of FIG. 3, 408 of FIG. 4). Ho states, in column 7, lines 18-40,

"If at 304, the destination identifier is determined to be a telephone number, than at 306, the communications device dials the number. **If at 308 a successful connection cannot be established then at 309 the failure is indicated by generating and displaying at 318 an appropriate message on the display 208 and then returning at 311 to a mode where a new transmit or receive function may be initiated.** Upon establishment of a successful connection, the communications device proceeds to transmit at 310, the information on the document 101 in accordance with a facsimile communications protocol to the remote fax device...If at 304, the destination device is determined to be an e-mail address, then at 312, the communications device establishes a SLIP/PPP connection with Router 107. If a successful connection is obtained (block 314), then at 316, the information on document 101 is transmitted in accordance with the STP to a remote mailbox identified by the destination identifier. **If at 314 a successful connection cannot be established then failure is so indicated on display 208 at step 318 and the device returns to a state where it can accept a new transmit or receive command.**" (emphasis added)

Hence, Ho's invention first determines what type of device it is sending to before it transmits a document and requires a successful connection with such a device before determining the format to send the data in and sending it. Ho's

invention would not work if it automatically sent both email and facsimile because it would not know which protocol to send the data with and could not send the data unless there was a direct connection.

It is well settled in the law that a 35 USC 103 rejection based on a modification of prior art that destroys the function of the invention disclosed in the prior art, is improper and does not establish a prima facie case of obviousness. *In Re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There is simply no technological motivation for a worker to make such a detrimental modification. To the contrary, a significant disincentive exists. In this case, the proposed formatting the message data for both transfer of a facsimile message and an email message would destroy the functionality of the Ho invention and so a prima facie case of obviousness cannot be established from the cited references.

In view of the lack of a prima facie case of obviousness, Claims 1-18 cannot be deemed to be unpatentable under 35 USC 103 over Ho in light of one skilled in the art at the time the invention was made.

Claims 1-18 stand rejected under 35 USC 103(a) as being unpatentable over Ho et al, U.S. Patent No. 5,805,298, in view of Okada, U.S. Patent No. 6,101,244. It is contended in the Office Action that Ho teaches all the claimed elements of the applicants' invention with the exception that Okada teaches transmitting a message via facsimile and then via email after a time lag. The Examiner further contended, however, that it would have been obvious to those skilled in the art to send the message via both facsimile and e-mail, thereby making the rejected claims obvious. The applicants respectfully traverse this contention of obviousness, and provide the following argument to show that these claims are nonobvious over the cited combination.

In order to deem the applicants' claimed invention unpatentable under 35 USC 103, a prima facie showing of obviousness must be made. To make a prima facie showing of obviousness, all of the claimed elements of an applicant's invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not

appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (In Re Fine, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Applicants claim a process for sending both electronic mail and facsimiles from a facsimile machine. The user activates an actuator to transmit a facsimile to both a facsimile telephone number and an electronic mail address.

Ho teaches a communications device that transmits and receives information in accordance with both facsimile and electronic mail communications protocols. The communications device recognizes a destination identifier, identifying a remote communications device as either a facsimile device or an email device and transmits a document in accordance with the communications protocol utilized by the identified device. In order to transmit the document, Ho's invention requires that there be a direct connection from Ho's communication device 100 to the receiving device. As shown in FIGs. 3 and 4, Ho does not transfer any document unless there is a successful direct connection (308, 310 and 318 of FIG. 3; 406, 408, 410 of FIG. 4). In fact, Ho indicates a failure if no such direct connection can be established (318 of FIG. 3, 408 of FIG. 4). Hence, Ho's invention first determines what type of device it is sending to before it transmits a document and requires a successful connection with such a device before determining the format to send the data in and sending it. Ho's invention would not work if it automatically sent both email and facsimile because it would not know which protocol to send the data with and could not send the data unless there was a direct connection. Furthermore, as shown in FIG. 3 if the Ho invention successfully sends the document via facsimile or email then it does not attempt to send it via the alternative method.

Okada teaches a communications terminal device which can data by means of electronic mail or facsimile. The communication terminal device first tries to send the data by electronic mail over a network. When a predetermined response is not received from the network during a network connection operation, or when there is mail returned in the sender's mail box, the

communication terminal device dials the facsimile number of the recipient and transmits the mail image data via facsimile connection. (See abstract.) If the network connection operation is successful then the data is never sent via facsimile connection. In either case, there is a significant delay between the first attempt to send the data over the network and the time the data is sent via facsimile. This is particularly true if the sender waits until the mail is returned to the sender's mailbox before the data is sent via facsimile.

Neither Ho nor Okada teach the applicants' claimed process and system for transferring a document via both email and facsimile. Nor does Ho and Okada in combination recognize the advantages of the applicants' claimed invention, namely the increased timeliness and increased reliability of the intended recipient of a document actually receiving such a transmission due to the redundant nature of the applicants' claimed invention caused by sending data both via facsimile and email.

Thus, the applicants have claimed elements not taught in the cited art and which have advantages not recognized therein. Accordingly, no prima facie case of obviousness has been established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that the rejected claims are patentable under 35 USC 103 over Ho and Okada. As such, it is respectfully requested that the rejection of Claims 1-18 be reconsidered based on the non-obvious claim language:

"A process for sending electronic mail and facsimiles from a facsimile machine comprising the steps of....the user activating said actuator to transmit a facsimile to the facsimile telephone number and electronic mail to the electronic mail address."

In summary, it is believed that the foregoing amendment and arguments have placed the claims in condition for allowance. Therefore, reconsideration of the rejection of Claims 1-18 is respectfully requested. In addition, allowance of

these claims at an early date is courteously solicited.

Respectfully submitted,

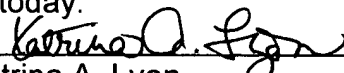


Katrina A. Lyon  
Registration No. 42,821  
Attorney for Applicants

LYON, HARR & DEFRANK, LLP  
300 Esplanade Drive, Suite 800  
Oxnard, CA 93030  
(805) 278-8855

CERTIFICATE OF MAILING

I hereby certify that the attached correspondence is being placed in First Class Mail addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 as of today.

 date: 4/16/01  
Katrina A. Lyon

**Version With Markings to Show Changes Made**

In the specification please change on page 11, please change "co-pending U.S. application entitled SYSTEM AND PROCESS FOR TRANSMITTING ELECTRONIC MAIL USING A CONVENTIONAL FACSIMILE DEVICE TITLE having serial no. \_\_\_\_\_ and a filing date of \_\_\_\_\_, the disclosure of which is incorporated herein by reference." to --co-pending U.S. application entitled SYSTEM AND PROCESS FOR TRANSMITTING ELECTRONIC MAIL USING A CONVENTIONAL FACSIMILE DEVICE TITLE having serial no. 09/187,365 and a filing date of November 6, 1998, the disclosure of which is incorporated herein by reference.--